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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

2161

DATE MAILED: 11/29/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

# Office Action Summary

Application No.

09/821,371

Applicant(s)

DIAZ ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1, 3-12, 14 and 16-55 is/are rejected.
- 7) ☒ Claim(s) 2 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The following has been noted by the examiner:

A) since U.S. Patent has not been assigned, the assent by the assignee/inventors has been received in the form of a reissue declaration as required by 37 CFR § 1.172(a).

B) the offer to surrender the original patent has been received pursuant to 37 CFR § 1.178(a).

C) the reissue seeks to broaden the claims.

D) the reissue application has been filed within 2 (TWO) years.

E) the reissue declaration fails to set forth at least one error as required by 37 CFR § 1.175(a)(1) since a statement of "inadequate claiming by failing to present claims is not an error see 35 U.S.C. § 251 and MPEP §§ 1401, 1402 & 1414.

F) the reissue declaration filed March 29, 2001 complies with 37 CFR § 1.175(a)(2).

3. The Abstract of the Disclosure is objected to because:

A) the abstract is not on a separate sheet as required by 37 CFR § 1.72(b).

Correction is required. See M.P.E.P. § 608.01(b).

4. The drawings are objected to because:

A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of:

(1) claims 33 & 52 in regard to using a graphical display format; must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).

Correction is required.

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4.1 Applicant is required to submit a proposed drawing correction in response to this Office action (37 CFR § 1.121(d)). However, correction of the noted defect can be deferred until the application is allowed by the examiner.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

6. Claims 3-6 & 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 Applicant's repeated references to "predetermined said user personal data" through out claims 3-6 & 8 lacks antecedent basis in claim 1, since claim 1 fails to recite either a coprocessor or predetermined said user personal data.

6.2 Applicant's repeated references to "claim 1" through out the body portions (that which appears after the word "comprises;") of claims 3-6 is confusing and unclear. Applicant should note the claim drafting practice of using the words "the" or "said" when referring back to a feature that has already been previously introduced in one or more of the claims in the chain of dependency.

6.3 Applicant's repeated references to "claim 1" through out the body portion (that which appears after the word "comprises;") of claim 8 is confusing and unclear, since this reference causes a confusion in regard to the dependency of this claim.

6.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for

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patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7.1 Claims 1, 3-12, 14, 16-35 & 37-54 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Williams, III (5,704,350).

7.1.1 In regard to claims 1, 3-12, 14, 16-35 & 37-54, Williams, III ('350) discloses a computerized device, including a processor, display and keyboard, for aiding the user in determining the total nutritional value consumed and calories expended during exercise base on the use recommended dietary allowance (RDA). To perform these tasks, this system computes the total nutritional value consumed by the user based on predetermined stored user data and stored nutrition data as selected from menus by the user input from the keyboard. Further, to perform these tasks, this system computes the total caloric value consumed by the user during exercise based on predetermined stored user data and user entered exercise data, including the amount of exercise time, via user input from the keyboard. Further, if the nutritional value of an additional item exceeds the RDA, a warning is given.

8. Claims 16-55 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

8.1 In the amendment filed May 22, 1998 and July 03, 1998 during the prosecution of U.S. Paten no. 5,890,128, applicant to remove a rejection under 35 U.S.C. § 102(a,b) based on prior art amending independent claims 1 & 15 to include an additional recitation of

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“nutrition/exercise menus” and further argued that the applied prior art does not teach this feature. Although claims 16 & 40 recite the selection of nutrition data and exercise data, these claims do not limit this selection to using menus as required by the above amendments to original claims 1 & 15. Hence, applicant is attempting to recapture subject matter lost during the prosecution of U.S. Paten no. 5,890,128.

9. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

9.1 The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

9.2 Claims 16-55 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

9.2.1 The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

10. The following is an Examiner's Statement of Reasons for indicating Allowability over the prior art:

A) in regard to claims 2 & 15, the prior art does not teach or suggest the use of a wireless communications link to enter exercise data.

B) in regard to claims 13, 15, 36 & 55 are the prior art does not teach or suggest the use of a password to access and/or create the user data.

11. The examiner has cited prior art of interest, for example:

A) Barron (3,984,666) which discloses determining the calories burned during exercise.

B) Brouns et al (EPO 0537113 A1) which disclose the need to replace nutritional supplements expended during exercise.

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C) Sugarman et al (5,796,640) which disclose a dietary aid to aid the user in determining the nutritional value of various items.

D) Goldberg which disclose a connection between the nutritional intake of a person over a period of time and the suggesting exercise.

12. Claims 2 & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

14.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

14.2 The fax phone number for OFFICIAL FAXES is (703) 746-7239.

14.3 The fax phone number for AFTER FINAL FAXES is (703) 746-7238.

11/17/01

  
Edward R. Cosimano  
Primary Examiner A.U. 2161